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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,089	07/08/2003	Xin Jin	10230	8689

7590 09/22/2005

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,089

Applicant(s)

JIN ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-86 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-13, 15, 40-51, and 53, drawn to a polymer, classified in class 526, subclass 259+.

II. Claims 14, 16-39, 52, and 54-86, drawn to a silsesquioxane and an electrophotographic element, classified in class 525, subclass 342, and class 430, subclass 58.2, respectively.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful, as itself, as a hole mobile polymer in an electroluminescence device, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or

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identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and as shown by their different classification, restriction for examination purposes as indicated is proper.

3. If applicants elect the invention of either Group I or Group II, applicants must also respond to the following election of species requirement.

This application contains claims directed to the following patentably distinct species of the claimed invention:

- The invention of Group I comprises distinct polymers obtained from distinct co-monomers.

Applicants are required to elect an ultimate species of invention, identifying the polymer as a unique polymer by identifying (1) the vinyl-substituted tertiary arylamine monomer and (2) the vinyl-substituted silane monomer used to obtain the

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polymer as unique chemical compounds. For example, in example 1 at pages 34-35, of the instant specification, the polymer obtained by reacting the monomers di(p-tolyl)aminostryene (DTAS) and methacryloxypropyl trimethoxysilane (MATMS).

Applicants should identify all claims that read on the ultimate elected species of invention comprising the uniquely identified polymer obtained from the uniquely identified monomers (1) and (2).

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 40, and 53 are generic.

- The invention of Group II comprises distinct silsesquioxanes obtained from a unique polymer or from a unique polymer and a unique silane monomer having at least one hydrolyzable group.

Applicants are required to elect an ultimate species of invention, where the following components are identified as unique chemical compounds:

- (1) The polymer is identified as a unique polymer by identifying (1) the vinyl-substituted tertiary arylamine monomer

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and (2) the vinyl-substituted silane monomer used to obtain the polymer as unique chemical compounds.

(2) Identifying whether or not the silane monomer having at least one hydrolyzable group is present. If the silane monomer is present, identifying the silane monomer as a unique chemical compound.

For example, in example 12 at pages 40-41, of the instant specification, the silsesquioxane obtained by reacting the polymer, which is obtained from the monomers DTAS and MATMS, with methyl trimethoxysilane, as the silane monomer having at least one hydrolyzable group.

Applicants should identify all claims that read on the ultimate elected species of invention comprising the uniquely identified silsesquioxane obtained by the uniquely identified polymer obtained from the uniquely identified monomers (1) and (2) with or without the uniquely identified silane monomer having at least one hydrolyzable group.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 14, 16, and 52 are generic.

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Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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4. Due to the complexity of the election of species requirements and the further requirement of the identification of the ultimate species of invention, applicants' representative was not contacted to request an oral election to the above restriction requirement.

5. Applicants are advised that the reply to this requirement to be complete must include an election of the invention, and if either Inventions I and II is elected, an election of the ultimate species of invention, to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD
Sep. 12, 2005

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700